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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,500	02/14/2005	Frank Bosse	P70338USD	6184
13% 7590 07/09/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER				
THROWER, LARRY W				
ART UNIT		PAPER NUMBER		
4111				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IP@JHIP.COM

### Office Action Summary

**Application No.**

10/524,500

**Applicant(s)**

BOSSE, FRANK

**Examiner**

LARRY THROWER

**Art Unit**

4111

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 10/13/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-7 and 10-14 in the reply filed on June 9, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 8-9 have been withdrawn.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the device for manufacturing film tracks where the pre-squeeze device is positioned before the lay-flat device in the direction of conveyance of the film tube must be shown or the feature(s) canceled from claim 2. No new matter should be entered.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: "slit" is misspelled as "silt". Appropriate correction is required.
5. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. See MPEP § 608.01(n). Claims 10-14 depend from dependent claims, and should not be separated by claims 8-9, which do not also depend from said dependent claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 2, 10, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2 in the instant application was mistranslated from parent application PCT/EP03/10504 to indicate the pre-squeeze device is positioned *before* the lay-flat device in the direction of conveyance of the film tube. There is no support in PCT/EP03/10504 as filed to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of a device for manufacturing film tracks where the pre-squeeze device is positioned before the lay-flat device in the direction of conveyance of the film tube.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claim 1, the phrase "consists preferably of" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

- Claims 1, 10 and 11 recite the limitation "the region". There is insufficient antecedent basis for this limitation in the claim.
- Claim 4 recites the limitation "the foil tracks". There is insufficient antecedent basis for this limitation in the claim.
- Claim 6 recites the limitation "the above claim". It is not clear from which of the "above" claims the instant claim depends. For the purpose of examining this claim, it is assumed that this claim is dependent on claim 1.
- Claim 6 recites the limitation "the reversing air turning bar". There is insufficient antecedent basis for this limitation in the claim.
- Claim 7 recites the limitation "the reversing device". There is insufficient antecedent basis for this limitation in the claim.
- Claims 2-3, 5 and 12-14 are rejected for depending from indefinite claim 1.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-7 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Klaus (DE 29621374; Derwent abstract acc-no 1997-110715).
- Regarding claim 1, Klaus discloses a device for the manufacture of film tracks (1a; 1b) of a film tube (9). The device includes a lay-flat device (7) which has two lay-flat

plates with a mutual roof-like formation (7), whereby their distance decreases in the direction of the conveyance of the tube (fig. 2); a squeeze roller device (12, 13) which has a squeeze roller pair (12, 13); a cutting device (14), which slits the film tube along its direction of conveyance; characterized in that in the direction of the film tube, before the squeeze roller device (12, 13), a pre-squeeze device is provided (10'); which leaves a remainder of air in the film tube, so that in the region between the squeeze roller device (12, 13) and the pre-squeeze roller device (10'), a static air cushion is formed (14; the "bubble" described in the Derwent abstract); and that the film tube (9) is slit with the cutting device (14) in the region of the static air cushion (fig. 2).

- Regarding claim 3, Klaus discloses the pre-squeeze device being a pre-squeeze roller pair (10').
- Regarding claim 4, Klaus discloses a reversing device (17), which reverses the film tracks generated in the slitting process with the cutting devices while the film tracks are lying apart (fig. 2).
- Regarding claim 5, Klaus discloses the pre-squeeze rollers (10') of the pre-squeeze roller pair arranged mutually in such a fashion that the walls of the film tube touch each other at least while passing through the pre-squeeze roller pair (fig. 2).
- Regarding claim 6, Klaus discloses a reversing device (20, 28) is capable of bypassing the reverse air turning bar (22) and at least one idle roller (27).
- Regarding claim 7, Klaus discloses a reversing device (22, 27) including a turning bar (22) and an idle roller (27), whereby the turning bar and the idle roller are

capable of carrying out a reversing motion about an axis that is orthogonal to the direction of revolution of the idle roller.

- Regarding claims 10-11, Klaus discloses a reversing device (20, 21) which reverses the film tracks generated in the slitting process with the cutting device (14) while the film tracks are lying apart (fig. 2).
- Regarding claims 12-14, Klaus discloses the pre-squeeze rollers (10') of the pre-squeeze roller pair arranged mutually in such a fashion that the walls of the film tube touch each other at least while passing through the pre-squeeze roller pair (fig. 2).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klaus (DE 29621374; Derwent abstract acc-no 1997-110715), as applied to claim 1 above.



- Klaus fails to disclose the pre-squeeze device (10') being positioned before the lay-flat device (7). However, Klaus discloses the lay-flat device being positioned before the pre-squeeze device (fig. 2). Whether the lay-flat device is positioned before or after the pre-squeeze device would have the same effect of squeezing the film tube to create a static air cushion in the film tube for cutting. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the film track manufacturing device of Klaus by repositioning the pre-squeeze device and lay-flat device in the direction of conveyance of the film tube because the end result of laying flat the film tube and creating a static air cushion would be the same.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is (571)270-5517. The examiner can normally be reached on Monday through Thursday from 7:30AM-5PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam C. Yao can be reached on 571-272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4111

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/  
Examiner, Art Unit 4111

/Sam Chuan C. Yao/  
Supervisory Patent Examiner, Art Unit 4111